

AMENDMENT  
1-15368REMARKS

Claims 32-44 and 53-55 were previously pending in the present application. Claims 32-36, 38-40, 53 and 55 have been amended. New Claims 56-61 have been added. Thus, Claims 32-44 and 53-61 are now pending in the present application. A deposit account authorization for the extra claims is attached hereto.

Claim Rejections - 35 USC §103

The Examiner rejects Claims 32-43 and 53-55 as being unpatentable, i.e. obvious, in view of the combination of Bartels, et al., US Patent Number 4,621,632 ('632) and US Patent Number 6,039,696 to Bell ('696). The Examiner states "Bartels, et al. teaches all of the limitations of the claims except for explicitly citing a humidity sensing means and a monitoring means connected to the humidity sensing means for monitoring the humidity of the gas in keeping it within a predetermined threshold. Bell teaches a humidity sensing means and a monitoring means for monitoring the humidity of the gas and keeping it within a predetermined threshold. It would have been obvious of ordinary skill in the art, at the time of the invention, to have modified the humidity device of Bartels, et al. to monitor humidity by a humidity sensing means as taught by Bell while keeping the humidity within a predetermined range or threshold for the well known purpose of preventing a cavity that is normally moist from drying out thereby causing inflammation causing discomfort such as the respiratory system or otherwise."

No Motivation to Combine Bartels, et al. ('632) with Bell ('696)

For the Examiner's *prima facie* case of obviousness to withstand scrutiny, three requirements must be met: (1) there must be some suggestion or motivation to combine the references (in this case, the '632 and '696 patents), and the suggestion may come from the

AMENDMENT  
1-15368

references themselves or from the knowledge generally known in the art (MPEP §2143.01); (2) a reasonable expectation of success is required; and (3) the prior art reference, or references when combined, must teach or suggest all the claim limitations.

There simply is no suggestion or motivation to combine the Bartels, et al. and Bell references, either in the references themselves, or from the knowledge generally known in the art. This is simply because Bartels, et al. does not need any indication of humidity. Bartels, et al. ('632) states, at column 8, lines 51-65, that it is only interested in overheating and over humidifying the air where it enters the flexible heating tube 36, and maintaining the temperature in tube 36, through the optional heater, to prevent rain out. In other words, Bartels, et al. always is at 100% relative humidity. There is no need for a device such as Bell.

The Examiner has not supported his motivation to combine argument.

The combination of the references can teach every element of the claimed invention, but, without a motivation to combine a rejection based on obviousness is improper *In re Rouffert*, 47 USPQ 2<sup>nd</sup> 1453 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references *Al-Shite Corp. v. SI International, Inc.*, 50 USPQ 2<sup>nd</sup> 1161 (Fed. Cir. 1999). When an Examiner maintains that there is an explicit or implicit teaching or suggestion in the prior art, the Examiner should indicate where (page and line or figure) such a teaching appears in the prior art. *In re Rijckaert*, 28 USPQ 2<sup>nd</sup> 1955 (Fed. Cir. 1993), and the Examiner has not done so.

Claim 44 is allowable over Bartels, et al. ('632), Bell ('696) and Ott ('474).

The Examiner next rejects Claim 44 as being obvious in view of the combination of Bartels, et al. and Daniel as applied to Claims 32-43 above and further in view of Ott, et al. ('474). Claim 44 depends on Claim 32 and is patentable for at least the reasons that Claim 32 is

AMENDMENT  
1-15368

patentable.

No Motivation to Combine Ott, et al. ('474) with Bell ('696)

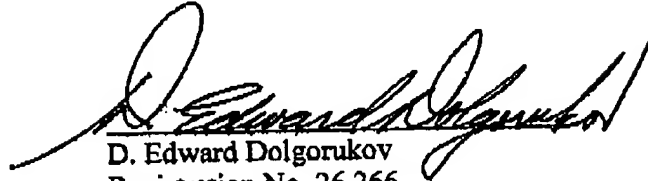
Lastly, the Examiner rejects Claims 32-44 and 53-55 as being obvious in view of the combination of Ott, et al. ('474) and Bell ('696). The combination of references is improper. The Examiner has engaged in hindsight reconstruction. While the device claimed in the ('474) patent was known at least since May of 1995, no person of ordinary skill in the art recognized that depletion of the water inside the device was a problem that could arise. This is the problem addressed by the present invention - a problem first recognized by the Applicant. The problem of drying of tissue, per se, was addressed by the invention described in the ('474) Patent. Without any appreciation of the problem in the art, there is no motivation to combine references, as the device in ('474) is capable of preventing the drying of tissue. The fact that no one realized the problem of depletion for at least three years after the device in the ('474) Patent was known is strong evidence of non-obviousness.

Further, even if the references could be combined, the combination would not have all the limitations of Claim 32. Bell shows a humidity sensing device 16 placed in a chamber 13 inside an adapter 12 placed in line in the breathing circuit of a patient having a artificial airway to measured inspired and expired gases. Claim 32 recites the detection of the humidity of the gas in the chamber where the gas is humidified. Thus, the combination proposed by the Examiner would not meet the limitations of the claims even if there were motivation to combine. Thus, it is believed that Claims 32-44 and 53-61 are clearly allowable over the combination of Ott ('474) and Bell ('696).

AMENDMENT  
1-15368

In view of the above amendments and the remarks explanatory thereof, a favorable reconsideration of the present application and the passing of this case to issue is courtesy solicited.

Respectfully submitted,



D. Edward Dolgorukov  
Registration No. 26,266

ATTORNEYS

MARSHALL & MELHORN, LLC  
Four SeaGate, Eighth Floor  
Toledo, Ohio 43604  
(419) 249-7100  
(419) 249-7151 (Facsimile)